

**REMARKS**

Claims 1-6 have been cancelled. Claims 7 and 14 have been amended.

Claims 8-13 remain in the application unchanged. Reexamination and reconsideration of the application are respectfully requested.

In the Office Action dated 11/02/2004, the Examiner objected to the disclosure in that the Abstract contained the word "thereof". A substitute Abstract has been provided that replaces the word "thereof" with the phrase --of the mounting member-- as the Examiner suggested. Thus, the Examiner's objection to the disclosure is believed to be overcome.

Claim 1 was rejected under 35 U.S.C. §102(e) as being anticipated by McCormack et al., U.S. Patent Publication No. 2002/0172574 A1 (hereinafter "McCormack et al. '574"). This claim has been cancelled.

Claims 1, 4, 5, and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tait et al., U.S. Patent No. 2,967,557 (hereinafter "Tait et al. '557") in view of Frattarola et al., U.S. Patent No. 5,611,654 (hereinafter "Frattarola et al. '654"), and further in view of McCormack et al. '574 and Allen, U.S. Patent No. 6,682,282 (hereinafter "Allen '282"). These claims have been cancelled.

Claims 2, 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tait et al. '557 in view of Frattarola et al. '654, McCormack et al. '574 and Allen '282, and further in view of Munro, U.S. Patent No. 2,948,317 (hereinafter "Munro '317"). These claims have been cancelled.

Claims 3, 7-11 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tait et al. '557 in view of Frattarola et al. '654, McCormack et al. '574, Allen '282, and Munro '317, and further in view of Peterson, U.S. Patent No. 4,505,058 (hereinafter "Peterson '058") and Swan, U.S. Patent No. 5,704,100

(hereinafter "Swan '100"). Claim 3 has been cancelled. Applicants believe that claims 7-11 and 14 are allowable over the cited references for the reasons discussed below.

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allen '282 in view of Swan '100. Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

### **Legal Standard for Claim Rejection Under 35 U.S.C. §103**

The test for obviousness under 35 U.S.C. §103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of Applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a §103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972). A reference which teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966).

A basic mandate inherent in §103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible

within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972).

When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolchem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). This position was reaffirmed in the case of *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). *Arkie Lures* involved the combination of a plastic fishing lure with salt materials to yield a highly attractive lure product. The prior art disclosed both concepts (salty bait and plastic lures) separately but not in combination. The CAFC ultimately held that the invention under consideration was not obvious. Even though both of the claimed features were disclosed by the cited art, the CAFC concluded that this was insufficient to prove a case of obviousness in the absence of a teaching or suggestion in the art to combine the references.

Likewise, the requirement that a concrete suggestion be present in the cited art for a proper obviousness rejection to be made is even further supported by *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). This case involved an allegation that a particular medical needle apparatus was merely a product of "obvious modifications" to a prior needle assembly. The CAFC disagreed and stated

that the claimed invention was neither suggested nor taught by the prior art, and further indicated that the "invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art" itself. 48 USPQ 2d at 1232 (emphasis added). The CAFC also concluded that the requisite suggestion or teaching was so important that, in its absence, the claimed invention could not have been obvious. According to the court, "Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground cannot stand. Consequently, the judgment of invalidity based on obviousness is reversed." 48 USPQ 2d at 1232.

#### **Rejection of Claims 3, 7-11 and 14**

As noted above, claims 3, 7-11 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tait et al. '557 in view of Frattarola et al. '654, McCormack et al. '574, Allen '282, and Munro '317, and further in view of Peterson '058 and Swan '100. Claim 3 has been cancelled. Applicants believe that claims 7-11 and 14 are allowable over the cited references for the following reasons.

**Tait et al. '557** is directed to a captive screw (15) with an annular cup (21) placed between the screw head (18) and the panel (10) to which the screw (22) is attached to prevent engagement of the screw head (18) with the panel (10). The screw (22) is attached to the panel (10) using a threaded receptacle (16) which fits only on a screw (22) having a matching thread type.

**Frattarola et al. '654** is directed to a captive nut (10) having a hollow knob portion (24) with an internally-threaded hole (26). The internally-threaded hole (26) is adapted to receive a threaded rod or screw (70) having a matching thread type.

**McCormack et al. '574** is directed to a captive screw (200) having a flange (214) on its head (208) that retains the screw (200) within the hollow bore (216) of a ferrule (204). The particular screw (200) that is enclosed within the ferrule (204) may not be removed from the ferrule (204).

**Allen '282** is directed to a rack mount panel fastener that is adapted to receive screws (54, 65) of different thread sizes. A screw (54, 65) is received within a ferrule (46) and is secured on the opposite side of a panel (40) with a mating retainer (64, 66) that is appropriate for the size of the screw (54, 65).

**Munro '317** is directed to a threaded fastener retaining device (29) having an opening (20) which receives a flexible member (21) that loosely engages a threaded fastener (25) so that it won't fall out of the retaining device (29). The threaded fastener (25) utilized is of a particular type: it has a first threaded portion (26) and a second threaded portion (28) separated by a smooth, reduced shank portion (27). Pressure on the threaded fastener (25) causes the flexible member (21) to separate and allows the threaded fastener (25) to be inserted or removed from the retaining device (29).

**Peterson '058** is directed to an excavating tooth (11) for heavy equipment that is held in place within an adapter (12) by a retainer (51). The retainer (51) has legs (53) with straight stretches (57) that hold the tooth (11) in place.

**Swan '100** is directed to a retaining clip system (20) for mounting two foreign surfaces to one another. A stud (30) is received within a hole (80) in a housing (40). A retaining clip (50) is received within a recess (66) in the housing (40). The stud (30) has an annular channel (37) that is adapted to receive the retaining pin (50), which holds the stud (30) to the housing (40).

None of these references, either alone or in combination, discloses or suggests Applicants' claim 7, with particular emphasis on the underlined elements which will be discussed in further detail below:

7. (Currently amended) A mounting device for securing an electronic device comprising at least one opening to an equipment rack comprising a plurality of openings, comprising:

- a) a mounting member comprising at least one flange, an opening extending at least partially around the circumference of said mounting member, an end portion receivable within said at least one opening in said electronic device, and an inner cylindrical portion adapted to receive at least a first fastener and a second fastener, said first fastener having a different thread type than said second fastener;
- b) a retainer member adapted to be received by said opening in said mounting member, said retainer member having a smaller diameter portion engaged with said first fastener or said second fastener in a latched mode which prevents one of said first fastener and said second fastener from being removed from said mounting member, and said retainer member having a larger diameter portion positioned adjacent to said first fastener or said second fastener in an unlatched mode which allows one of said first fastener and said second fastener to be removed from said mounting member and the other of said first fastener or said second fastener to be inserted into said mounting member; and
- c) a securing device mounted on said end portion of said mounting member which is adapted to secure said mounting member to said electronic device.

First, many of the cited references, including Tait et al., Frattarola et al. '654, McCormack et al. '574, Munro '317, Peterson '058, and Swan '100 do not disclose a mounting member having an inner cylindrical portion that is adapted to receive fasteners of different thread types (e.g., different-sized screws). In fact, neither Peterson '058 nor Swan '100 even mention threaded fasteners. Munro '317 discloses only a particular threaded fastener having a smooth shank portion (27) between threaded portions (26, 28), and does not suggest any other threaded fasteners. Tait '557 and McCormack et al. '574 disclose captive screws (15, 200, respectively), and Frattarola et al. '654 discloses a captive nut (10), which clearly do not allow interchangeability with different-sized screws.

The only cited reference that discloses a mounting member (ferrule 46) adapted to receive different-sized screws is Allen '282, which has a common inventor and assignee with the present application. However, Allen '282 does not disclose Applicants' mounting member as claimed, nor does this reference disclose the retainer member claimed in Applicants' claim 7. Furthermore, any combination of Allen '282 with the other references in an attempt to create Applicants' claim 7 would be inappropriate. As noted above, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolchem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). A concrete suggestion must be

present in the cited art for a proper obviousness rejection to be made. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). Since none of the above references presents a concrete suggestion to provide a mounting device that is capable of holding different-sized screws, nor do they even suggest the desirability of doing so, it would not be obvious to combine these references with Allen '282 in an attempt to create Applicants' invention as claimed in claim 7.

In view of the above, Applicants believe that claim 7 is allowable. Dependent claims 8-11 are also believed to be allowable as depending from an allowable base claim, and further because of the novel and nonobvious combination of elements contained therein.

Applicant's claim 14 is believed to be allowable for the same reasons as claim 7, and the arguments presented above are herein renewed for claim 14. For these reasons, Applicants believe that claim 14 is now in condition for allowance.

#### **Rejection of Claims 12 and 13**

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allen '282 in view of Swan '100. Applicants believe that these claims are allowable over the cited references for the following reasons.

As noted by the Examiner on page 11 of the Office Action, Allen '282 fails to disclose a retainer member as claimed in Applicants' claim 12. The Examiner also states that "Swan teaches a system having a similar retainer member (50) used to permit both latched and un-latched modes with a fastener of different cross sections.... In the instant case, different thread types may be considered different cross-sections." Applicants respectfully disagree. First, the type of fastener that Swan '100 discloses is a stud (30), i.e., it is not a threaded fastener. Thus, this



reference does not suggest utilizing fasteners of different thread types. In addition, as noted above relative to claim 7, it would be inappropriate to combine Allen '282 with Swan '100 since Swan '100 does not even mention threaded fasteners.

In view of the above, Applicants believe that claim 12 is allowable. Dependent claim 13 is also believed to be allowable as depending from an allowable base claim, and further because of the novel and nonobvious combination of elements contained therein.

### Conclusion

For at least the reasons discussed above, Applicants believe that all of the pending claims (claims 7-14) are allowable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the application and grant an early allowance.

Should there be any questions regarding this Amendment, the Examiner may contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.



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